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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,051	06/02/2005	John Francis Dufort	001058-00025	4299

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EXAMINER

LOWEN, ALYSSA

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/517,051

Applicant(s)

DUFORT, JOHN FRANCIS

Examiner

Alyssa M. Lowen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24,26,27 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24,26,27 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 recites the limitation "the pivot pins" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 9, 18-22, 24, 27, 29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (3596380). Williams discloses a spinning top (Fig. 7) having a unitary one-piece body (13) with a substantially continuous outer perimeter (Fig. 7) and a stem (12) that is moveable from a first position in which the stem lies substantially parallel to the body (Fig. 1) and a second position in which the stem extends perpendicularly through a center opening in the body (Fig. 7). The stem is received within a recess on the body and is entirely received within the body when in the first position (Figs. 1 & 2). The stem can be moved back to the first position after

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use (Figs. 7 & 1) and is separable from the body (Fig. 5). The stem is pivotally mounted on the body (column 1 lines 5-12) and the opening is sized to allow the stem to move there through when moving between the first and second positions (Fig. 7). The stem is formed with a convex latch portion (19) that engages a corresponding concave latch portion (24) on the body when the stem is in the second position (Fig. 7) to prevent rotation of the stem with respect to the body. The profile of the stem varies along its length with a section of larger cross-sectional area located about half way along its length giving the stem a circular profile with a rounded tip (Fig. 7).

5. Claims 1-2, 6-7, 18-21, 23-24, 26 and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Rubino (4954116). Rubino discloses a spinning top having a body of unitary one-piece construction and substantially continuous outer perimeter (11) with a stem (Fig. 4a) that is moveable between a first position in which it lies substantially parallel to the body (Fig. 1) and a second position in which it extends perpendicularly through a center opening in the body (Fig. 5). The stem is separable from the body (Fig. 1) and can be moved back to the first position after use (abstract). The stem has a first latch portion in the form of screw threads or tabs (19) for engaging a corresponding second latch portion (20) on the body when the stem is in the second position (Fig. 5) to prevent rotation of the stem with respect to the body. The profile of the stem varies along its length with a section of larger cross-sectional area located about half way along its length (Fig. 4a). The stem can have a rounded (Fig. 4a) or a pointed (Fig. 10) tip with a handle portion at its upper end (Fig. 4a).

6. Claims 1-5, 7, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Johanningmeier (2945696). Johanningmeier discloses a spinning top having a unitary one-piece body (7) with a substantially continuous outer perimeter (Fig. 3) and a separable stem (27) that is moveable from a first position in which the stem lies substantially parallel to the body (Fig. 5) by its location within the body (column 1 lines 56-57) and a second position in which the stem extends perpendicularly through a center hole in the body (Fig. 1). The stem is received within a recess on the body when in the first position (Figs. 1 & 5) and has a handle portion and a rounded tip (Fig. 2).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8, 10-11 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams as applied to claims 1, 9 and 29 above and further in view of Pfister (DE 10013829 A1). Pfister discloses a spinning top having a body (12) and a stem (11). The stem is movable between a first position where the stem is entirely received within the body such that it is substantially parallel to the body (Fig. 1A) and a second position in which the stem extends perpendicularly through an opening or first recess formed in the body (Fig. 1B). The stem has transverse arms or pivot pins (119) protruding from its sides that engage holes or second recesses (14) in the body to pivotally mount the stem to the body by forming a bridge that connects on one end

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to the body and on the other end to the stem (Figs. 1A & 1B). It would have been obvious to one of ordinary skill in the art from the teaching of Pfister to attach arms to the stem of Williams in order to keep the stem portion securely attached to the device so as to eliminate small parts that could be a choking hazard if swallowed by a child.

9. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams or Rubino and Heidenreich (1139119). Williams or Rubino discloses the basic inventive concept, substantially as claimed, with the exception of an outer element. Heidenreich discloses a circular disk shaped piece of paper with a center hole that functions as an outer element attaching to and extending over a majority of a top part of a body and partially secured by a flange on the body of the toy (page 1 lines 47-53). It would have been obvious to one of ordinary skill in the art from the teaching of Heidenreich to include the outer element in order to incorporate advertising matter onto the toy. The outer element being removably mounted to the top and bottom of the body would have been an obvious matter of design choice to a person of ordinary skill in the art because Applicant has not disclosed that having the outer covering being removable from both the top and bottom of the body provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the covering being permanently adhered to just the top of the body because it would allow an advertisement to be easily seen and prevent a person from removing the advertisement at a later time. In regard to the outer element being made of resilient material, examiner notes that the mere selection of known materials as recited in claim 17, on the basis of

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suitability for the intended use would be entirely obvious. See in re Leshin, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art to provide Heidenreich with resilient material in order to use a known material suitable for the intended use.

Response to Arguments

10. Applicant's arguments with respect to claims 1-24, 26-27 and 29-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Lowen whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AML



EUGENE KIM
SUPERVISORY PATENT EXAMINER